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Customer Number

Patent
Case No.: 57965US006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: SUZUKI, SHIGERU

Application No.: 10/519217

Confirmation No.: 7313

Filed: June 5, 2003

Group Art Unit: 2831

Title: SLIDINGLY DETACHABLE CORE MEMBER AND COLD SHRINK TUBE UNIT
HAVING THE SAME

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the final action dated January 24, 2007, and prior to filing an appeal brief, a Panel Review of the legal and factual basis of the rejections in the above-identified application is hereby requested. No amendments are being filed with this request. This Pre-Appeal Brief and Request for Review is being filed with a Notice of Appeal.

Fees:

- ☒ It is believed that no fee is due. However, if necessary, charge any additional fee, or credit any overpayment to Deposit Account No. 13-3723.
- ☐ Any required fee will be paid at the time of EFS-Web submission.

REMARKS

Status of the Claims:

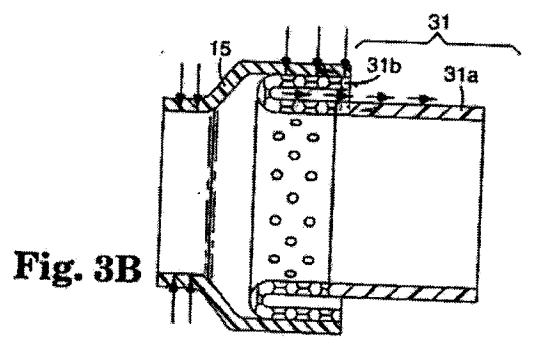
Claims 1-10 are pending. Claims 1-6 and 8-10 stand rejected. The Examiner has found claim 7 allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Review is requested for the following reasons:

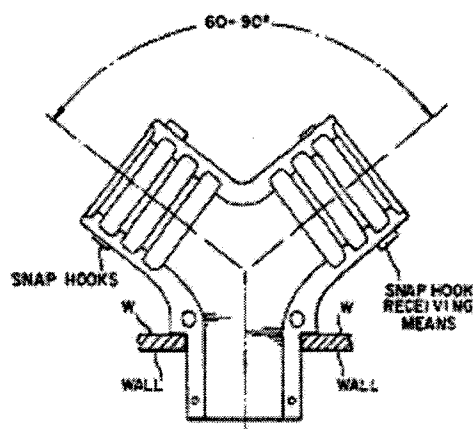
Claims 1-4 and 8-10 were rejected under 35 U.S.C. §103(a) as being unpatentable for obviousness over Nakamura et al. (WO 95/11542) in view of Braun et al. (US 5,277,459). Claims 5 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable for obviousness over Nakamura et al. in view of Braun et al. as applied to claim 1 and further in view of Omani et al. (US 6,472,600).

To establish a *prima facie* case of obviousness, four basic criteria must be met. First, a prior art reference must be analogous art. Second, from the prior analogous art, there must be a suggestion or motivation in the prior art to modify or combine reference teachings. Third, there must be a reasonable expectation of success in modifying or combining reference teachings. Finally, the combined prior art references must teach or suggest all claim limitations. *See* MPEP § 706.02(j). *See King Instrument Corp. v. Otari Corp.*, 767 F.2d 853 (Fed. Cir. 1985). *See In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In order to modify or combine the cited references, the Examiner is required to provide a suggestion or motivation to modify or combine reference teachings, from which there must also be a reasonable expectation of success. The law clear that "in order to prevent a hindsight-based obviousness analysis, there must be a *reason, suggestion, or motivation*," thereby preventing one of ordinary skill in the art from exploiting hindsight when combining references. *See Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000) (emphasis added).

In this case, Applicant respectfully asserts there is no motivation to combine Braun et al. with Nakamura et al. It is clear to Applicant that Braun conflicts with both Nakamura and the present invention. Furthermore, as respectfully submitted, *infra*, Braun not only conflicts with both Nakamura and the present invention—it actually *teaches away* from the intended operation.



Nakamura teaches a removable core, which includes a slip member having a low friction, interposed between the inner periphery of an elastic covering member and the outer periphery of the core. When the slip member and the removable core are connected with each other in an end-to-end manner, the slip member can be pulled out together with the removable core. In this manner, the final resultant product that is produced from pulling the removable core and the slip member is a cable or other such device covered by an elastic covering member. In other words, the removable core and slip member are not used in the industrial application of the final resultant product. Rather, the removable core and the slip member are collectively used as a removable core member.



As understood by those skilled in the art, removable cores for cold-shrink applications have never included joint portions, and the inclusion of a joint portion in a removable core is an impressive improvement by Applicant. Braun, to be sure, discloses **not** a removable core, but rather a generalized pipe connector structure, as understood by those skilled in the art. Braun

makes no teaching or suggestion regarding disposing the hinged pipe connector as a removable core between a cold shrink elastic covering member and a cable, nor does it teach or suggest pulling the hinged pipe connector from between a cold shrink elastic covering member and a cable, nor does it teach or suggest completely removing the hinged pipe connector from the final resultant product of a cable sealed with an elastic covering member, as specifically taught in Nakamura. In other words, a pipe connector is not even remotely similar in structure or function to a removable core. The hinged pipe connector is the final resultant product in Braun—not even remotely similar to a pullout tool for use in cold-shrink applications as in Nakamura. Nowhere does Braun even slightly teach or suggest utilizing the disclosed hinged plate-like pipe connector within the context of a removable plate-like core for cold shrink elastic covering applications. Therefore, absent a hind sighted assessment of Applicant's claimed invention, a person of ordinary skill in the art would not have sought out Braun for the purpose of a combination with Nakamura, because neither Braun nor Nakamura teach or suggest such a motivation. Therefore, clearly there is no motivation explicitly nor implicitly within the references to combine the reference teachings based on what each discloses as a whole.

Furthermore, Nakamura's disclosure demonstrates that Braun actually *teaches away* from any such combination. A combination reference teaches away from the primary reference if its combination renders the primary reference unsatisfactory for its intended purpose or changes the principle of operation of the primary reference. See MPEP § 2145 Section X.D.; MPEP § 2141.02 Section VI; MPEP § 2143.01 Sections V-VI. The foundational principle of operation of Nakamura is to 1) dispose a core and a slippery section inside an elastic covering member to hold the elastic covering member in an expanded state, and 2) remove the core together with the slippery section from contact with the elastic covering member. The intended purpose of the core in Nakamura is to hold the elastic covering member in an expanded state, and thereby effectuate tightening of the elastic covering member around a cable after removing the core from contact with the elastic covering member. The inclusion of the pipe connector of Braun into the elastic covering member of Nakamura is problematic because pipe connectors are not designed to function as removable cores that hold an elastic covering member in an expanded state, nor are pipe connectors designed in such a way to be removed from an elastic covering member after holding the elastic covering member in an expanded state. Any use of the pipe connector of Braun as the removable core of Nakamura would essentially render Nakamura inoperable and

unworkable because the pipe connector cannot function whatsoever as a removable core. A pipe connector has no "slippery section" structure or other characteristic that might allow the pipe connector to be removed from a position holding the elastic covering member in an expanded state. In summary, pipe connectors are not even remotely operable as removable cores in cold shrink articles. Therefore, any attempt at combining Braun with Nakamura would change Nakamura's principle of operation and clearly render Nakamura unsatisfactory and/or nonfunctional for its intended purpose of providing a slippery removable core for cold shrink applications. For this reason, Applicant respectfully disagrees with the Examiner's conclusion.

With all respect to the Examiner, there are absolutely no express or implied admissions or failings in the cited references that provide a compelling motivation that that the cited art must somehow be modified, changed, fixed, or improved upon, and especially none relating to the modifications asserted by the Examiner. Furthermore, persons skilled in the art would clearly understand and appreciate that pipe connector structures could not possibly be used as removable cores in cold shrink applications. Such a notion would be frankly absurd to a skilled artisan in the cold shrink industry. It is clear that the Examiner has combined references to reconstruct Applicant's claimed invention by utilizing improper piece-by-piece hindsight reasoning after using Applicant's claimed invention as a roadmap, which is prohibited by MPEP § 706.02(j) and MPEP § 2143.01.

Applicant respectfully requests review and withdrawal of this rejection.

Conclusion

For at least these reasons, Applicant respectfully requests review and withdrawal of the obviousness rejection of claims 1-4 and 8-10 over Nakamura et al. (WO 95/11542) in view of Braun et al. (US 5,277,459) and claims 5 and 6 over Nakamura et al. (WO 95/11542) in view of Braun et al. (US 5,277,459) and further in view of Omani et al. (US 6,472,600). The pipe member of Braun simply cannot be used in any manner as a removable core in Nakamura, and the combination of Braun and Nakamura completely distorts the intended principle of operation.

By setting forth the clear grounds of error, Appellants do not assert that these are the only errors that the Examiner has made, nor do Appellants waive any arguments that may be asserted in an Appeal Brief. Accordingly, Appellants reserve the right to present additional arguments in the Appeal Brief in relation to the independent and also the dependent claims.

Appellants respectfully request that the panel review and reverse the final rejections of claims 1-6 and 8-10 in the above-identified application, and that a Panel Decision allowing the application on the existing claims be issued.

Respectfully submitted,

Date

3/2/07

By:



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